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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,284	11/23/1999	QINGHONG CAO	CAO-2-2-11-1	3630

7590 11/28/2006

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EXAMINER	
LY, NGHI H	

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/447,284	CAO ET AL.	
	Examiner	Art Unit	
	Nghi H. Ly	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,5,9,10,14,15,19,20,24,25,28 and 29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5,9,10,14,15,19,20,24,25,28 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 4, 5, 8, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-8, 11-13, 17, 18, 21-23, 27 and 30-52 of copending

Application No. 10/959,186. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are same scope, limitation and meaning.

Regarding claims 1, 2, 4, 5, 8, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29, Application No. 10/959,186 teaches a cordless telephone, comprising: a remote handset, a base unit matched to said remote handset, and an MPEG audio player integrated within at least one of said remote handset and said base unit, wherein said remote handset of said cordless telephone can switch between performing as a telephony device and performing as said MPEG audio player (see Application No. 10/959,186, claims 6-8, 11-13, 17, 18, 21-23, 27 and 30-52).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP07212829A) in view of Borland et al (US 6,556,965) and further in view of Rydbeck (WO 99143136).

Regarding claims 1 and 29, Sato teaches a cordless telephone (see Title and Abstract), comprising: a remote handset (see Drawing handset 37), a base unit matched to the remote handset (see Drawing base unit 24), and an audio player integrated within at least one of the remote handset and the base unit (see Title, Abstract and Detailed Description).

Sato does not specifically disclose an MPEG audio integrated within at least one of the remote handset and the base unit.

Borland teaches an MPEG audio integrated within at least one of the remote handset and the base unit (see Abstract, column 5, lines 37-40, column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3", also see column 3, line 65 to column 4, line 7, "MPEG" and see column 5, lines 24-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset.

Rydbeck teaches the remote handset can switch between performing as a telephony device and performing as audio player (see page 7, lines 2-4), the switching being initiated upon activation of a button on the remote handset (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Sato and Borland in order to prevent telephone conversation from interfering with audio sounds.

Regarding claim 2, the combination of Sato, Borland and Rydbeck teaches the MPEG audio player is integrated within the remote handset (see Sato, Title, Abstract and Detailed Description and see Borland, column 5, lines 24-28).

Regarding claims 4 and 5, Borland further teaches the MPEG audio player is an MP3 (see Sato, Title, Abstract and Detailed Description and see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3").

7. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP07212829A) in view of Borland et al (US 6,556,965) and further in view of Tuoriniemi et al (US 5,978,689).

Regarding claims 9, 10, 19 and 20, Sato teaches a method of integrating an MPEG audio player in a cordless telephone (see Title and Abstract) comprising: playing

of the pre-loaded music from the remote handset of a cordless telephone (see Title, Abstract and Detailed Description), connecting a base unit of the cordless telephone to a public switch telephone network (the base unit of cordless telephone of Sato inherently connect to a public switch telephone network).

Sato does not specifically disclose a method of integrating an MPEG audio player in a cordless telephone and playing of the pre-loaded MP3.

Borland teaches a method of integrating an MPEG audio player in a cordless telephone and playing of the pre-loaded MP3 (see column 5, lines 24-28 and column 4, lines 27-33, see "storage in portable systems" and column 4, lines 43-47, see "playback").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of

Sato and Borland so that the user won't miss the telephone call while enjoy listening to music.

8. Claims 14, 15, 24, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP07212829A) in view of Borland et al (US 6,556,965) and further in view of Segal et al (US 6,167,251).

Regarding claims 14 and 24, Sato teaches a method of integrating an audio player in a cordless telephone (see Title and Abstract) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (the base unit of cordless telephone of Sato inherently connect to a public switch telephone network), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 37-40).

Sato does not teach a method of integrating an MPEG audio in a cordless telephone comprising: the downloaded digital bit stream music comprised in an MPEG format.

Borland teaches a method of integrating an MPEG audio in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3", and see column 3, line 65 to column 4, line 7, "MPEG") comprising: the downloaded digital bit stream music comprised in an MPEG format (see column 3, line 65 to column 4, line 7, "MPEG").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format to said remote handset directly from a remote bit stream audio source, and storing said downloaded digital bit stream music comprised in an MPEG format in said remote handset, wherein said downloaded digital bit stream music comprised in an MPEG format is stored in Flash memory in said remote handset.

Segal teaches downloading digital bit stream music comprised in an MPEG format to said remote handset directly from a remote bit stream audio source (see column 30, line 15-32 and fig.3), and storing said downloaded digital bit stream music comprised in an MPEG format in said remote handset (see column 30, line 15-32 and fig.3), wherein said downloaded digital bit stream music comprised in an MPEG format is stored in Flash memory in said remote handset (also see column 30, line 15-32 and fig.3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Segal into the system of Sato and Borland for later playback (see Segal, column 30, lines 23-24).

Regarding claims 15, 25 and 28, Sato teaches a method of integrating an audio player in a cordless telephone (see Title and Abstract) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (the base

unit of cordless telephone of Sato inherently connect to a public switch telephone network) comprising: playing music from a remote handset of the cordless telephone (see Title, Abstract and Detailed Description).

Sato does not specifically disclose playing MP3 music from a remote handset of the cordless telephone and the remote bit stream music comprised in a MPEG format to the remote handset via an Internet.

Borland teaches playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28) and the remote bit stream music comprised in a MPEG format to the remote handset via an Internet (column 4, lines 27-33, see "transmission through Internet").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.

Segal teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source (see column 30, line 15-32 and fig.3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Segal into the system of Sato and Borland for later playback (see Segal, column 30, lines 23-24).

Response to Arguments

9. **a**. Applicant's arguments with respect to claims 1, 2, 4, 5, 8, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 have been considered but are moot in view of the new ground(s) of rejection.

b. Applicant's arguments filed 09/05/06 have been fully considered but they are not persuasive.

On pages 7-9 of applicant's arguments, applicant argues that no motivation to combine Borland and Rydbeck.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so found in the knowledge generally available to one of ordinary skill in the art in order to prevent telephone conversation from interfering with audio sounds.

On page 8 of applicant's arguments, applicant argues that Rydbeck teaches a cellular telephone not a remote handset of the cordless phone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone comprising a base unit and a remote handset (see fig.2, base unit 120 and handset 110) that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"), Rydbeck the remote handset can switch between performing as a telephony device and performing as audio player and the switching being initiated upon activation of a button on the remote handset of the cordless telephone (see page 7, lines 2-4) and the combination of Borland and Rydbeck does indeed teach applicant's claimed invention as recited by claims 1, 2, 4, 5 and 29. In addition, Rydbeck's handset and Borland's cordless handset are communication devices, and those skilled in the art would appreciated that the teaching of Rydbeck can also be used in the cordless telephone without changing the scope and spirit of Rydbeck's invention.

On pages 11-13 of applicant's arguments, applicant argues that no motivation to combine Borland and Tuoriniemi.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to

do so found in the knowledge generally available to one of ordinary skill in the art so that the user won't miss the telephone call while enjoy listening to music.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly